

UNITED STATES PATENT AND TRADEMARK OFFICE

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: JAMES MROZINSKI, JAYSHREE SETH
AND JAMES THORSON

Application No. 09/876,704

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on October 9, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

APPEAL BRIEF

Appellant filed an Appeal Brief dated October 4, 2006, in response to the Notification of Non-Compliant Appeal Brief mailed September 22, 2006. The Appeal Brief is not in compliance with the new rules of 37 CFR § 41.37(c) effective September 13, 2004.

Status of Claims

The "Status of Claims" section does not properly identify the appealed claims.

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37 CFR § 41.37(c)(iii) states:

(iii) *Status of claims*. A statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed.

Argument

An examination of the application reveals that the Appeal Brief filed October 4, 2007, lists the “Grounds of Rejection to Be Reviewed on Appeal” [page 6] as follows:

1. Claims 1, 4-7, 13-15, 18-20, 23-25, 29, 30 and 39-44 stand rejected under 35 U.S.C. 102(e) as anticipated by Matsuo et al (US Patent No. 6,492,307);
2. Claims 1, 4-7, 13-15, 18-20, 23-25, 29, 30 and 39-44 stand rejected under 35 U.S.C. 103(a) as obvious over the combination of this same Matsuo et al (US Patent No. 6,492,307 in view of Hansen et al (US Patent No. 6,533,119);
3. Claims 26-28, 31-33, 35-38, 45-53 and 55-72 stand rejected under 35 U.S.C. 103(a) as obvious over the combination of this same Matsuo et al (US Patent No. 6,492,307 in view of Kondo (PCT WO 99/29220); and
4. Claims 1, 4-9, 12-15, 18-33 and 55-72 stand rejected under 35 U.S.C. 103(a) over Kondo (PCT WO 99/29220) in combination with Sugiyama et al. (US 4,643,939).

Each grounds of rejected on appeal must be clearly identified and argued separately in the Arguments section of the brief. 37 CFR 41.37(c)(1)(vii) states:

(vii) Argument. The appellant's contentions with respect to each ****ground of rejection presented **** and the basis for those contentions, including citations of authorities, statutes, and parts of the record relied on, should be presented in this section. A statement which merely points out what a claim recites will not be considered an argument for patentability of the claim.

Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. The failure of appellant to separately argue claims which appellant has grouped together constitutes a waiver of any argument that the Board must consider the patentability of any grouped claim separately. See *In re McDaniel*, 293 F.3d 1379, 1384, 63 USPQ2d 1462, 1465-66 (Fed. Cir. 2002). Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number.

It should be noted that the Appellant does not specifically identify the claims being rejected under each specific ground of rejection he is arguing in the Appeal Brief. For example note page 6, last paragraph, appellant discusses the 103(a) rejection based on Kondo combined with Sugiyama; but appellant does not identify what claims he is arguing under these particular rejection.

CONCLUSION


Accordingly, it is

ORDERED that the application is returned to the Examiner to:

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- 1) hold the Appeal Brief filed on October 4, 2006 defective;
- 2) to notify Appellants to file a Substitute Appeal Brief, correlating the specific claims being rejected with the specific ground(s) of rejection, in compliance with 37 CFR § 41.37(c);
- 3) for the Examiner to consider the substitute Appeal Brief; and
- 4) for such further action as may be appropriate.

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